

REMARKS

Claims 1, 3-9, 12-28 and 20-41 are pending in this application after this Amendment. In light of the remarks made herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection.

In the outstanding Official Action, the Examiner rejected claims 1, 3-9, 12-13, 16-18 and 20-40 under 35 U.S.C. § 103(a) as being unpatentable over *Lazzouni et al.* (USP 5,652,412) in view of *Marianetti, II et al.* (USP 5,889,888); and rejected claims 14-15 under 35 U.S.C. § 103(a) as being unpatentable over *Lazzouni et al.* in view of *Marianetti, II et al.* and further in view of *De Schrijver* (WO 00/00928). Applicant respectfully traverses these rejections.

Claim Rejections – 35 U.S.C. § 103 - Lazzouni et al./Marianetti, II et al.

In support of the Examiner's rejection of claim 1, the Examiner asserts the following:

Regarding claims 1, 25-26, *Lazzouni et al.* discloses a handheld electronic device (see portable and field use of the input device, see col. 1, lines 19-20, and col. 2, lines 60-61) which is adapted to carry out at least one operation, comprising: registration device (see pen 10, fig. 3); and processor means (see microprocessor for processing and recording the position information, see col. 4, lines 30-35) for carrying out an operation upon determination of said command, wherein the registration device (10) is adapted to record the command electronically by detecting a position code arranged on a writing surface, upon which the command is written (see abstract, see col. 5, lines 7-12).

The Examiner admits that *Lazzouni et al.* does not disclose registering strokes when a device and interpretation means for determining if the strokes comprise a command. The Examiner relies on *Marianetti, II et al.* to cure the deficiencies of the teachings of *Lazzouni et al.* citing to the Abstract and column 4, lines 10-14. The Examiner concludes that it would have been obvious to one skilled in the art to combine the teachings of *Marianetti, II et al.* with the teachings of *Lazzouni et al.* because "this would recognize strokes that present characters from a different character set." Applicant respectfully disagrees with the Examiner's characterization of

these references and further disagrees that there is sufficient motivation to combine the teachings of the references.

The disclosure of *Lazzouni et al.* is directed to a pen and paper information recording system. At column 5, lines 7-12 *Lazzouni et al.* discloses as follows:

Alternatively, any other writing instrument that has a fountain pen configuration, which requires the user to tip the pen in a preferred direction, can be used for making markings on the encoded paper 14. The pen further includes an optical reading system (not shown in FIGS. 2A and 2B) for sensing the encoded information on paper 14. The optical reading system is described in detail below in connection with FIG. 3. The pen should be similar in size and shape to conventional writing instruments.

However, Applicant maintains that these teachings are insufficient to teach or suggest a registration device adapted to record a command electronically by detecting a position code arranged on a writing surface upon which the command is written. There is no teaching or suggestion in *Lazzouni et al.* that is directed to recording commands electronically by detecting a position code as claimed. As *Marianetti, II et al.* fails to cure the deficiencies of the teachings of *Lazzouni et al.*, Applicant respectfully submits that the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements. As such, it is respectfully requested that outstanding rejection be withdrawn.

In addition to the above argument, Applicant maintains that there is insufficient motivation to combine these teachings as suggested by the Examiner. The Examiner asserts that one skilled in the art would have been motivated to combine the teachings of the cited references because this would recognize strokes that present characters from a different character set. However, in column 5, lines 55-60, to switch between input modes, the user taps the stylus on the proper mode box. A single recognition system may be used for the combined input box 760 except that a different stroke and character data sets are used depending on the current mode. The Examiner relies on column 4, line 10-14 to disclose an interpretation means for determining if the strokes comprise a command as recited in the present claim 1. As such, the Examiner's statement regarding recognizing strokes that present characters from a different character set are

unrelated to determining whether strokes comprise a command. Thus, the Examiner's asserted motivation for combining the teachings does not address why one skilled in the art would be so motivated to combine the command stroke of *Marianetti, II et al.* with the pen and paper information recording system of *Lazzouni et al.*

Further, Applicant maintains that one skilled in the art would not be motivated to combine the teachings of *Lazzouni et al.* with the teachings of *Marianetti, II et al.* As there is insufficient motivation to combine the teachings, Applicant maintains that the Examiner has failed to establish *prima facie* obviousness in support of the rejection of claim 1. For these reasons, Applicant maintains that claim 1 is patentable over the references as cited and it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 3-9, 11-15, and 41 are allowable for the reasons set forth above with regard to claim 1, at least based upon their dependency on claim 1. It is further respectfully submitted that claim 16-18 and 25-26 include elements similar to those discussed above with regard to claim 1 and thus these claim, together with the claims dependent thereon are patentable over the references as cited by the Examiner.

Examiner Interview

This Reply is being filed concurrently with a Request for Examiner Interview. Prior to formally considering these arguments on the record, Applicant respectfully requests that the Examiner contact the undersigned to schedule and conduct a personal interview.

Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No.

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52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By _____

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